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| 09/889,023  | 01/10/2002  | Toshihiro Morita     | 450101-02844        | 4611             |
| 22850   | 7590        | 05/31/2006           | EXAMINER            |                  |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.<br>1940 DUKE STREET<br>ALEXANDRIA, VA 22314 |             |                      | CHEN, TE Y          |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2161                |                  |

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/889,023

**Applicant(s)**

MORITA ET AL.

**Examiner**

Susan Y. Chen

**Art Unit**

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 41-43 and 48-68 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 41-43 and 48-68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>July 10, 2001</u> . | 6) <input type="checkbox"/> Other: _____  |

***Response to Amendment***

***Claim Status***

This office action is in response to the amendment filed on Feb. 27, 2006. Claim 41-43, 48-68 are pending for examination, claims 41-43, 48-66 have been amended, claims 67-68 have been newly added.

***Claim Objections***

Claims 41, 67, 68 are objected to under 37 CFR 1.75 as being a substantial duplicate of claim 48.

Claim 53 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 55.

Claim 60 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 62.

When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 41-43 and 48-68, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As to claims 41, 48, 53, 55, 60, 62 and 67-68, these claims recite "to create at least two filtering packages based on the at least two filtering data sets... at any given time" are new matters, because they are not supported by the present specification as indicated by applicant at page 12, 4<sup>th</sup> paragraph of instant amendment. In fact there is no description in the original filed specification that specifically disclosed the claimed features, hence, the specification is not in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As to claims 42-43, 49-52, 54, 56-59, 61 and 63-66, these claims have the same defects as their base claim, thus, are rejected for the same reason.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 41-43 and 48-68, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 41, 48, 53, 55, 60, 62 and 67-68, the claim language extensively use the term "configured to" but the instant specification fails to provide actual steps to perform or limit these claims to a particular structure, thus, this term renders the claimed scope to be indistinct. See *In re Markman v. Westview Instruments*, 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir.) (en banc), off 'd, U.S., 116 Ct. 1384 (1996).

As to claims 42-43, 49-52, 54, 56-59, 61 and 63-66, these claims have the same defects as their base claims respectively, thus, are rejected for the same reason.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 41-43 and 48-68, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,412,012 issued to Bieganski et al. (hereinafter referred as '012 Bieganski) in view of U.S. Patent No. 6,959,288 issued to Medina et al. (hereinafter referred as '288 Medina).

Claims 41, 48, 53, 55, 60, 62 and 67-68:

Bieganski discloses an information processing system as claimed [e.g., Fig. 1] comprising:

- a recording unit for recording usage history data and the related data recorded in the recording means based on at least two filtering data set [e.g., the CPU (102, Fig. 1) can coupled to the memory system (104, Fig. 1) and the secondary storage(108 of Fig. 1) to log history data indicative of usage history of the group of contents. For example, the data being stored in the History Set (203),

Fig. 2; or the customer's behavior data recorded at a shopping set being specified at col. 8, lines 7-8; or the Purchased Items associated to a particular user's Transaction or the total number of Transaction being purchased of the unit 900, Fig(s). 9; the Recommendation sets generated by the engine (600, Fig. 14; col. 14, lines 31-33));

- a computing unit for computing per each of the contents a weight related to a number of checkout from the history data and the related data recorded in the recording means based on the filtering data [e.g., the compatibility modifier (200, Fig. 2) can accept a stored number of checkout (or the number of times each item was purchased, Fig. 9) per each of the contents from the history data on a filtering rule specified by a marketer or customer or the processing of recommendation engine itself (col. 9, lines 63-49) to compute a weight related to the number of checkout (the steps 752-756, Fig. 7A)];
- a selecting unit for selecting a content from a group of contents based on weight computed by the computing means [e.g., the user interface adapter coupled to the Input Device (114, 118, Fig 1) can be used to select the modified recommendation set based on weight computed by the

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compatibility modifier (Fig. 5; Fig. 6; col. 13, line 21 - col. 14, line 14; col. 14, line 31-col. 15, line 2)];

- a displaying unit for display a list of at least titles in the information related to the contents selected by the selecting means [e.g., the Display Adapter (112, Fig. 1) coupled to the Display Device (116, Fig. 1) can display a list of recommended books selected by the book reviewer (col. 7, lines 49-54)].

'012 Bieganski did not specifically disclose that the selection unit configured to create at least two filtering packages based on the at least two filtering data sets, wherein each of the at least two filtering packages includes information identifying the content selected, and the information identify the content is capable of being shared by at least two filtering packages so as to allow the content to belong to both the at least two filtering package at any given time.

However, '288 Medina discloses the claimed features [e.g., col. 11, lines 7-30, col. 68, lines 13-67, the content processing tool of Fig.(s) 8, 12-13 and associated texts]

'012 Bieganski and '288 Medina are in the same endeavor to facilitate the sharing of group of content data via open network user interface, therefore, with the teachings of Bieganski and Medina in front of him/her, it would have been obvious for one of the ordinary skill person in the art at the time the invention was



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made to modify Bieganski's system with the technique taught by Medina to provide the selection unit as claimed that is configured to create at least two filtering packages based on the at least two filtering data sets, wherein each of the at least two filtering packages includes information identifying the content selected, and the information identify the content is capable of being shared by at least two filtering packages so as to allow the content to belong to both the at least two filtering package at any given time. Because by doing so, as suggested by Medina the combined system will provides a standard for creating digital players on end-user device that facilitates an end user to distribute, share and manage of a local library of digital contents no other than what was purchased [e.g., col. 5, lines 39-53, Fig.(s) 8, 12-13 and associated texts].

As to claims 42, 49, 51-52, 54, 56, 58-59, 61, 63, and 65-66:

Except all the features recited in claims 41, 48, 53, 55, 60, and 62, the combined system of Bieganski and Medina further discloses that the system comprising means to computes per each of the contents as weight for a period for which the content has been checked out or for the genre of the content or for playing time of the content [e.g., '288 Medina: col. 13, lines 1-9; col. 93, line15].

As to claims 43, 50, 57 and 64:

Except all the features recited in claims 41, 48, 53, 55, 60, and 62, the combined system of Bieganski and Medina further discloses that the system

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comprising means for adding new filtering data [e.g., '288 Medina: col. 11, lines 19-22].

### ***Response to Arguments***

Applicant's arguments based on newly amended features with respect to claims 41-43 and 48-68 filed on Feb. 27, 2006 have been considered but are moot in view of the new ground(s) of rejection as discussed above.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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***Points of Contact***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Y. Chen whose telephone number is 571-272-4016. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Susan Y Chen  
Examiner  
Art Unit 2161

May 17, 2006



**UYEN LE  
PRIMARY EXAMINER**